

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

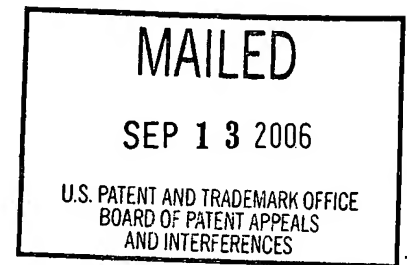
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TADASHI TAKANO and SUSUMU ANDO

Appeal No. 2006-1880
Application No. 10/064,363

ON BRIEF



Before HAIRSTON, LEVY, and MACDONALD, Administrative Patent Judges.

MACDONALD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1, 4, and 6. Claims 2, 3, and 5 have been canceled.¹

¹Contrary to Appellants' brief at page 1, claim 5 is not on appeal before this Board.

Invention

Appellants' invention relates to an armature for a revolving field electrical machine and more particularly to an improved armature construction that permits winding to a maximum density and a simplified winding method.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. An armature for a rotating machine having a circular core of a magnetic material and a plurality of magnetic pole teeth extending radially from said circular core and terminating at terminal ends spaced from said circular core, each of said magnetic pole teeth defining a core and an enlargement formed at the terminal end of said core, to define slots formed between adjacent magnetic pole teeth, each of said slots having a mouth formed between adjacent enlargements, an insulating bobbin having a circular portion lying on one side of said circular core and leg portions that extend for the length of said pole teeth at least on the sides of said slots and insulator extending portions extending at least along the side of said enlargements facing said circular core and defining a fixed and open clearance slot therebetween for protecting windings formed by a winding needle from damage by the winding needle and for forming a fixed clearance opening to receive at least a portion of the winding needle.

References

The references relied on by the Examiner are as follows:

Ebbert	3,276,275	Oct. 4, 1966
Scherzinger et al (Scherzinger)	5,698,923	Dec. 16, 1997

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Rejections At Issue

Claims 1, 4, and 6 stand rejected under 35 U.S.C. § 102 as being anticipated by Scherzinger.

In the alternative, claims 1, 4, and 6 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Scherzinger and Ebbert.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.²

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated infra, we affirm the Examiner's rejection of claims 1, 2, and 6 under 35 U.S.C. § 102 and we affirm the Examiner's rejection of claims 1, 2, and 6 under 35 U.S.C. § 103. For purposes of this decision we treat independent claim 1 as representative of the claims on appeal.

² Appellants filed an Appeal Brief on January 21, 2006. Appellants filed a Reply Brief on April 4, 2006. The Examiner mailed an Examiner's Answer on March 27, 2006.

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**I. Whether the Rejection of Claims 1, 4, and 6 Under
35 U.S.C. § 102 is proper?**

It is our view, after consideration of the record before us, that the disclosure of Scherzinger does fully meet the invention as recited in claims 1, 4, and 6. Accordingly, we affirm.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. See In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

With respect to independent claim 1, Appellants argue at page 4 of the brief, "the individual insulator pieces of Scherzinger et al have no part corresponding to the area identified by the reference numeral 38 in appellants' structure." The Examiner correctly responds at page 5 of the answer "reference number 38 is not claimed." Appellants then correct their argument at page 1 of the reply by pointing to reference numeral 58 in their figures. We find either version of the

argument unpersuasive. Appellants' claim language requires "a circular portion lying on one side of said circular core." We find such a circular portion in Scherzinger at Fig. 2, as part of the flange 36. The back half of flange 36 is shown as "a circular portion lying on one side of said circular core" as required by claim 1. Nothing in claim 1 requires that the "circular portion" correspond to the circular portion of Appellants' reference numeral 58; and nothing in the language of claim 1 precludes the circular portion of Scherzinger.

Appellants further argue that claim 1 is patentable because "each insulator segment [32] in Scherzinger et al only extends on one side of the gap between the enlarged outer ends of the pole teeth." We disagree. The plurality of insulator segments in Scherzinger form the "insulating bobbin" recited in claim 1. Nothing in the language of claim 1 precludes a multi-segment bobbin structure such as in Scherzinger.

Lastly, Appellants argue claim 1 is patentable because Scherzinger fails to teach "how the teeth are wound." We disagree. We find the language of claim 1 directed to how the teeth are wound is an intended use of the claimed bobbin

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structure. It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable. **See In re Schreiber**, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997), as follows:

A patent applicant is free to recite features of an apparatus either structurally or functionally. **See In re Swinehart**, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971) ("[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims."). Yet, choosing to define an element functionally, i.e., by what it does, carries with it a risk. As our predecessor court stated in **Swinehart**, 439 F.2d at 213, 169 USPQ at 228: where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. **See also In re Hallman**, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981); **In re Ludtke**, 441 F.2d 660, 663-64, 169 USPQ 563, 565-67 (CCPA 1971).

We find that the examiner therefore correctly found that Scherzinger established a prima facie case of anticipation. At that point, the burden shifted to Appellant to show that the prior art structure did not inherently possess the functionally defined limitations of his claimed apparatus. **In re Schreiber**, 128 F.3d at 1478, 44 USPQ2d at 1432 (Fed. Cir. 1997).

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Because Appellant has failed to demonstrate that the functional characteristics of his claimed invention are not inherent in the structure disclosed by Scherzinger, we affirm the rejection of the claims under 35 U.S.C. § 102.

**II. Whether the Rejection of Claims 1, 4, and 6 Under
35 U.S.C. § 103 is proper?**

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 1, 4, and 6. Accordingly, we affirm.

In view of the above discussion, it is our view, that since Scherzinger discloses all that is claimed, Ebbert is not necessary for a proper rejection under 35 U.S.C. § 103 of representative claim 1. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399,

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1402, 181 USPQ 641, 644 (CCPA 1974).³ Accordingly, the Examiner's obviousness rejection of claims 1, 4, and 6 is sustained based on Scherzinger alone.

Conclusion


In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 102 of claims 1, 4, and 6.

³ The Board may rely on less than all of the references applied by the Examiner in an obviousness rationale without designating it as a new ground of rejection. **In re Bush**, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961); **In re Boyer**, 363 F.2d 455, 458 n.2 150 USPQ 441, 444 n.2 (CCPA 1966).


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No time period for taking any subsequent action in
connection with this appeal may be extended under
37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED


KENNETH W. HAIRSTON
Administrative Patent Judge


STUART S. LEVY
Administrative Patent Judge


ALLEN R. MACDONALD
Administrative Patent Judge

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